

REMARKS

The present application was filed on May 15, 2001 with claims 1-22, all of which remain pending. Claims 1, 7, 9, 12, 16, 18 and 20-22 are the independent claims.

In the Decision on Appeal dated June 5, 2008 (hereinafter “the Decision”), the Board: (i) reversed the Examiner’s rejection of claims 16 and 17 under 35 U.S.C. §101 as being directed to non-statutory subject matter; (ii) affirmed the Examiner’s rejection of claim 20 under 35 U.S.C. §101 as being directed to non-statutory subject matter; (iii) affirmed the Examiner’s rejection of claims 1-22 under 35 U.S.C. §103(a) as being unpatentable over U.S. Patent No. 6,102,406 to Miles et al. (hereinafter “Miles”) in view of WO 00/41067 to Kay (hereinafter “Kay”); and (iv) issued a new ground of rejection under 37 CFR 41.50(b) for claims 16 and 17 under 35 U.S.C. §112, first paragraph, for being expressed as single means claims.

Applicants hereby reopen prosecution of claims 16 and 17 under 37 CFR 41.50(b)(1). Applicants have canceled claims 1-15 and 18-20 without prejudice solely in order to expedite prosecution of claims 16 and 17.

Claim 16, as amended, recites an object control system comprising a storage medium storing a program; and a processor coupled to the storage medium. The program causes the processor to change a location of an object on the network in order to move the object across the network. The object is embedded in a web page stored at a web site on a network. The network comprises a plurality of web sites, each web site comprising a plurality of web pages. Changing the location of the object on the network comprises the steps of removing the object from a first web page on a first web site on the network; and, upon removing the object from the first web page on the first web site on the network, incorporating the object into a second web page on a second web site on the network.

Support for the amendment to claim 16 may be found in the present specification at, for example, page 5, lines 20-24; page 6, lines 14-26; and page 8, line 24, to page 9, line 6.

Claims 16 and 17, as amended, are no longer drafted in means-plus-function format and therefore is not a single means claim. For at least this reason, it is believed that the present amendments to claims 16 and 17 are sufficient to overcome the §112, first paragraph, rejection.

With regard to the §103(a) rejection of claims 16 and 17, Applicants respectfully note that MPEP 1214.01 indicates that “[p]rosecution before the examiner of the 37 CFR 41.50(b) rejection can incidentally result in overcoming the affirmed rejection even though the affirmed rejection is not open to further prosecution. Therefore, it is possible for the application to be allowed as a result of the limited prosecution before the examiner of the 37 CFR 41.50(b) rejection.”

Applicants respectfully submit that the present amendment to claim 16 also overcomes the §103(a) rejection of claim 16. Specifically, claim 16, as amended, contains limitations which are neither taught nor suggested by Miles and Kay. Specifically, as noted above, claim 16 has been amended to recite a limitation directed to removing the object from a first web page on a first web site on the network; and, upon removing the object from the first web page on the first web site on the network, incorporating the object into a second web page on a second web site on the network.

Applicants respectfully submit that this limitation was not recited in claims 1-21, and thus was not deemed obvious by the Board. Instead, on page 10, first paragraph, the Board states that claim 12, which recited a limitation “wherein the main server incorporates a specific object into a first specific web page and removes the specific object from a second specific web page stored in the specific web server,” merely “requires that an object may appear and disappear from one page, as no causal relationship between the appearance on one page and the disappearance from another page is claimed.” Accordingly, the Board contends that this limitation is met by Kay, page 6, line 17, characterized as teaching “the appearance and disappearance of the object from a web page.” As such, the Board has at least suggested, if not stated, that a claim similar to claim 16, which specifies such a relationship, would be patentable over the references of record.

Dependent claim 17 is patentable at least by virtue of its dependency from independent claim 16, and also recites patentable subject matter in its own right. Accordingly, Applicants believe that the present amendments have incidentally resulted in the affirmed rejection of claims 16 and 17 being overcome even though the affirmed rejection is not open to further prosecution.

In view of the above, Applicants respectfully request withdrawal of the §112, first paragraph, and §103(a) rejections of amended claims 16 and 17. Applicants believe that the present application is in condition for allowance, and such favorable action is respectfully solicited.

Respectfully submitted,

A handwritten signature in black ink, appearing to read 'William E. Lewis', with a stylized, flowing script.

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